REMARKS

Claims 85 and 102-135 are pending this application. Claims 103 and 135 have been withdrawn from consideration. The claims have been amended as indicated above and support for the amendments throughout the text of the specification and the Figures.

Rejection under 35 U.S.C. § 102

Claims 102, 107-110, 114-116, 121-123, and 125-134 have been rejected under 35 USC § 102(b) as anticipated by US Patent No. 4,362,353 to Cobaugh et al. for the reasons noted on pages 2-6 of the Office Action. Applicants respectfully traverse these rejections.

The Office argues that the features in the rejected claims are described by Cobaugh et al. in the contact clip 14 as illustrated in Figures 1-5 and their accompanying description. The Office, however, has not substantiated that Cobaugh et al. describe the feature in some of the amended claims of an electronic interconnect element containing a first and second leaf portions where the first and opposite sides of the first leaf portion and the first and opposite side of the second lead portions are substantially parallel.

Cobaugh et al. describe that contact clips 14 are used to hold and connect the active device substrate 10 to a printed circuit board (PCB) 12. *See column 2, lines 22-29.* The Office argues that the contact clips 14 contain a first leaf portion (from 44 to 42 and 32) and a second leaf portion (56, 58, and 60). The Office further argues that the first and opposite sides of these two leaf portions are substantially parallel.

Applicant respectfully disagrees with this interpretation of the disclosure of Cobaugh et al. As depicted in the highlighted version of Figure 4 (attached as Exhibit A), the first and opposite sides of the first leaf portion (highlighted in yellow) are not substantially parallel to the first and opposite sides of the second leaf portion (highlighted in red). If anything, the skilled artisan would understand them to be arguably perpendicular.

As well, the Office has not shown that Cobaugh et al. describe the feature in some of the amended claims of a contact tip that is disposed to electrically engage a contact feature of an electronic device. The Office agues that this claimed feature is described by Cobaugh et al. in the tip 42 located on a first side of the first leaf portion and disposed to engage a contact feature of an electronic device 10. Applicant respectfully disagrees with this interpretation of the disclosure of Cobaugh et al.

Cobaugh et al. describe that contact clips 14 electrically connect conductive pads (not shown in Figure 1) on the underside of substrate 10 to traces on the PCB. *See column 2, lines 25-28.* As illustrated in Figure 1, the tip 42 of the contact clip 14 actually contacts the upper surface of the substrate 10. But since the conductive pads of the substrate 10 are located on the underside of the substrate 10, the skilled artisan would have understood that the tip 42 of the contact clip 14 would not make the electrical connection to the substrate 10. Such an understanding is supported by Cobaugh et al. when this reference describes that knob 54 (which contacts the underside of substrate 10 as shown in Figure 1) is the contact point for an engagement with a pad on substrate 10. *See column 3, lines 10-12.*

Further, amended claim 129 recites that a contact tip structure is joined directly to said beam structure. The Office argues that Cobaugh et al. describe such a feature since contact clip 14 contains a contact tip structure (42) that is joined to the beam structure (36). But the skilled artisan would recognize that the contact tip structure (42) is not joined directly to the beam structure (36) since contact tip structure (42) is joined directly to the first leaf portion (44 to 42 and 42).

Thus, the Office has not substantiated that Cobaugh et al. anticipates each and every feature in the rejected claims. Accordingly, Applicants respectfully request withdrawal of this ground of rejection.

Rejection under 35 U.S.C. § 103

Claims 85, 104-106, 111-113, 117-119, and 124 have been rejected as being obvious in view of Cobaugh et al. for the reasons noted on pages 7-10 of the Office Action. Applicants respectfully traverse this ground of rejection.

As noted above, the Office has not shown that Cobaugh et al. teach the claimed feature that the first and opposite sides of the first and second leaf portions are substantially parallel. Nor has the Office argued that such a feature would have been obvious to the skilled artisan in light of disclosure of Cobaugh et al. And in light of the express disclosure of Cobaugh et al. in the Figures, it would be unlikely that that Office could make such a showing.

Further, the Office has not shown that Cobaugh et al. describe the claimed feature of a contact tip that is disposed to electrically engage a contact feature of an electronic device. Nor has the Office argued that such a feature would have been obvious to the skilled artisan in light

of disclosure of Cobaugh et al. And in light of the express disclosure of Cobaugh et al., it would be unlikely that that Office could make such a showing.

Further, the Office has not shown that Cobaugh et al. describe the claimed feature of a contact structure that is joined directly to a beam structure. Nor has the Office argued that such a feature would have been obvious to the skilled artisan in light of disclosure of Cobaugh et al. And in light of the express disclosure of Cobaugh et al., it would be unlikely that that Office could make such a showing.

The Office admits that Cobaugh et al. do not disclose all of the features in claim 85, but argues that it would have been obvious for the skilled artisan to select a known material based on its suitability for the intended use. Applicant does not dispute that selection of a known material based on its suitability for its intended use can support a *prima facie* obviousness determination. But the Office has not substantiated with any evidence that the art has recognized that the material recited in claim 85 is known for the intended use alleged by the Office. *See M.P.E.P. § 2144.07.*

The Office also admits that Cobaugh et al. do not disclose all of the features in claims 104-105, but argues that they would have been obvious to the skilled artisan since it has been held that duplication of essential working parts of a device involves only routine skill in the art. In relying on legal precedent for such a rejection, though, the Office has incorrectly cited the legal theory. The legal theory is that mere duplication of parts has no patentable significance "unless a new and unexpected result is produced." *See M.P.E.P. § 2144.04(VI)(B).*

The Office also admits that Cobaugh et al. do not disclose all of the features in claims 106 and 124, but argues that they would have been obvious to the skilled artisan since constructing a formerly integral structure in various structures involves only routine skill In relying on legal precedent for such a rejection, though, the Office has incorrectly cited the legal theory. The legal theory is the exact opposite: using a "one piece construction instead of the structure disclosed in [the prior art (that comprised several parts rigidly secured together as a single unit)] would be merely a matter of obvious engineering choice." *See M.P.E.P. § 2144.04(V)(B).*

The Office also admits that Cobaugh et al. do not disclose all of the features in claims 111-113, but argues that they would have been obvious to the skilled artisan since it has been held that discovering an optimum value of a result-effective variable involves only routine skill.

But to meet it's burden for such a rejection, the Office must show that this parameter is recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. *See M.P.E.P. § 2144.05(II)(B)*. But the Office has not substantiated with any evidence that the features in claims 111-113 are taught by Cobaugh et al. to be result-effective variables.

The Office also admits that Cobaugh et al. do not disclose all of the features in claims 117-119, but argues that they would have been obvious to the skilled artisan since a change in shape is obvious and Applicant has presented no evidence that the claimed configurations are significant. Applicant has already presented evidence of the advantages of such a configuration in pages 87-88 of the specification.

The Office similarly admits that Cobaugh et al. do not disclose all of the features in claim 120, but argues that they would have been obvious to the skilled artisan since absent any evidence of the criticality of the design, such a design is obvious. Applicant disagrees with this legal precedent: Applicant need not show the "criticality" of this design. *See M.P.E.P. § 2144.04(IV)(B)*. In any event, Applicant has already presented evidence of the advantages of this configuration in pages 84-85 of the specification.

Thus, the Office has not substantiated that Cobaugh et al. teach or suggest every feature in the rejected claims. Accordingly, Applicants respectfully request withdrawal of this ground of rejection.

CONCLUSION

In view of the foregoing, as well as the reasons of record, Applicant requests withdrawal of the pending grounds of rejection and allowance of the pending claims.

If the Examiner believes that a discussion with Applicants' attorney would be helpful, the Examiner is invited to contact the undersigned at (801) 328-3600.

Respectfully submitted,

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